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Suite 600  
San Jose, CA 95110  
Direct Tel: (408) 975-7970  
Facsimile: (408) 975-7501  
[sneal@kenyon.com](mailto:sneal@kenyon.com)

## FACSIMILE TRANSMITTAL SHEET

TO:	Examiner Jonathan J. JOHNSON	FROM:	Stephen T. Neal
COMPANY:	USPTO	DATE:	November 3, 2005
FAX NUMBER:	(571) 273-8300	TOTAL NO. OF PAGES INCLUDING COVER:	15
PHONE NUMBER:		SENDER'S REFERENCE NUMBER:	12553/94
RE:	10/603,444	YOUR REFERENCE NUMBER:	Group Art Unit: 1725

☐ URGENT ☒ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY ☐ CONFIRMATION  
☐ ORIGINAL WILL FOLLOW ☒ ORIGINAL WILL NOT FOLLOW

## Notes/Comments:

APPEAL BRIEF

1. Fax Cover Sheet (1)
  2. Transmittal Form (1)
  3. Fee Transmittal Form (and one copy) (2)
  4. Appeal Brief (11)
- Total: (15) pages

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Dated: November 3, 2005

Signature:

A handwritten signature in cursive script that reads 'Barbara Vance'.

Barbara Vance

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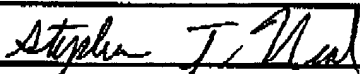
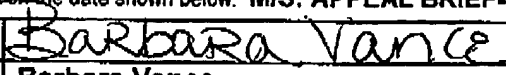
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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/603,444	
	Filing Date	June 24, 2003	
	First Named Inventor	Ming Gao YAO et al.	
	Art Unit	1725	
	Examiner Name	Jonathan J. JOHNSON	
Total Number of Pages in this Submission	15	Attorney Docket Number	12553/94

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ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) ____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <b>1. Facsimile Cover Sheet</b>
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Kenyon & Kenyon		
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Printed Name	Stephen T. Neal		
Date	November 3, 2005	Reg. No.	47,815
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Signature			
Typed or printed name	Barbara Vance	Date	November 3, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.  
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<h2 style="margin: 0;">FEE TRANSMITTAL</h2> <h3 style="margin: 0;">for FY 2005</h3> <p style="font-size: small; margin: 5px 0;">Effective 10/01/2004. Patent fees are subject to annual revision.</p> <p><input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27</p>		<p style="text-align: center; font-size: small;">Complete if Known</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%;">Application Number</td> <td>10/603,444</td> </tr> <tr> <td>Filing Date</td> <td>June 24, 2003</td> </tr> <tr> <td>First Named Inventor</td> <td>Ming Gao YAO et al.</td> </tr> <tr> <td>Examiner Name</td> <td>Jonathan J. JOHNSON</td> </tr> <tr> <td>Art Unit</td> <td>1725</td> </tr> <tr> <td>Attorney Docket No.</td> <td>12553/94</td> </tr> </table>		Application Number	10/603,444	Filing Date	June 24, 2003	First Named Inventor	Ming Gao YAO et al.	Examiner Name	Jonathan J. JOHNSON	Art Unit	1725	Attorney Docket No.	12553/94
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<p><b>TOTAL AMOUNT OF PAYMENT (\$)</b> 500.00</p>		<div style="border: 1px solid black; padding: 5px; display: inline-block;"> <b>RECEIVED</b>  <b>CENTRAL FAX CENTER</b>  <b>NOV 03 2005</b> </div>													

<p><b>METHOD OF PAYMENT (check all that apply)</b></p> <p><input type="checkbox"/> Check <input type="checkbox"/> Credit card <input type="checkbox"/> Money <input type="checkbox"/> Other <input type="checkbox"/> None</p> <p><input checked="" type="checkbox"/> Deposit Account:</p> <p>Deposit Account Number: <b>11-0600</b></p> <p>Deposit Account Name: <b>Kenyon &amp; Kenyon</b></p> <p>The Director is authorized to: (check all that apply)</p> <p><input checked="" type="checkbox"/> Charge fee(s) indicated below <input checked="" type="checkbox"/> Credit any overpayments</p> <p><input checked="" type="checkbox"/> Charge any additional fee(s) or any underpayment of fee(s)</p> <p><input checked="" type="checkbox"/> Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.</p>				<p><b>3. ADDITIONAL FEES</b></p> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th colspan="2">Large Entity</th> <th colspan="2">Small Entity</th> <th rowspan="2">Fee Description</th> <th rowspan="2">Fee Paid</th> </tr> <tr> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Code</th> <th>Fee (\$)</th> </tr> </thead> <tbody> <tr><td>1051</td><td>130</td><td>2051</td><td>65</td><td>Surcharge - late filing fee or oath</td><td></td></tr> <tr><td>1052</td><td>50</td><td>2052</td><td>25</td><td>Surcharge - late provisional filing fee or cover sheet</td><td></td></tr> <tr><td>1053</td><td>130</td><td>1053</td><td>130</td><td>Non-English specification</td><td></td></tr> <tr><td>1812</td><td>2,520</td><td>1812</td><td>2,520</td><td>For filing a request for ex parte reexamination</td><td></td></tr> <tr><td>1804</td><td>920*</td><td>1804</td><td>920*</td><td>Requesting publication of SIR prior to Examiner action</td><td></td></tr> <tr><td>1805</td><td>1,840*</td><td>1805</td><td>1,840*</td><td>Requesting publication of SIR after Examiner action</td><td></td></tr> <tr><td>1251</td><td>120</td><td>2251</td><td>60</td><td>Extension for reply within first month</td><td></td></tr> <tr><td>1252</td><td>450</td><td>2252</td><td>225</td><td>Extension for reply within second month</td><td></td></tr> <tr><td>1253</td><td>1,020</td><td>2253</td><td>510</td><td>Extension for reply within third month</td><td></td></tr> <tr><td>1254</td><td>1,590</td><td>2254</td><td>795</td><td>Extension for reply within fourth month</td><td></td></tr> <tr><td>1255</td><td>2,160</td><td>2255</td><td>1,080</td><td>Extension for reply within fifth month</td><td></td></tr> <tr><td>1401</td><td>500</td><td>2401</td><td>250</td><td>Notice of Appeal</td><td></td></tr> <tr><td>1402</td><td>500</td><td>2402</td><td>250</td><td>Filing a brief in support of an appeal</td><td>500.00</td></tr> <tr><td>1403</td><td>1,000</td><td>2403</td><td>500</td><td>Request for oral hearing</td><td></td></tr> <tr><td>1451</td><td>1,510</td><td>1451</td><td>1,510</td><td>Petition to institute a public use proceeding</td><td></td></tr> <tr><td>1452</td><td>500</td><td>2452</td><td>250</td><td>Petition to revive - unavoidable</td><td></td></tr> <tr><td>1453</td><td>1,500</td><td>2453</td><td>750</td><td>Petition to revive - unintentional</td><td></td></tr> <tr><td>1501</td><td>1,400</td><td>2501</td><td>685</td><td>Utility issue fee (or reissue)</td><td></td></tr> <tr><td>1502</td><td>490</td><td>2502</td><td>245</td><td>Design issue fee</td><td></td></tr> <tr><td>1503</td><td>660</td><td>2503</td><td>330</td><td>Plant issue fee</td><td></td></tr> <tr><td>1460</td><td>130</td><td>1460</td><td>130</td><td>Petitions to the Commissioner</td><td></td></tr> <tr><td>1807</td><td>50</td><td>1807</td><td>50</td><td>Processing fee under 37 CFR 1.17 (q)</td><td></td></tr> <tr><td>1806</td><td>180</td><td>1806</td><td>180</td><td>Submission of Information Disclosure Stmt</td><td></td></tr> <tr><td>8021</td><td>40</td><td>8021</td><td>40</td><td>Recording each patent assignment per property (times number of properties)</td><td></td></tr> <tr><td>1809</td><td>790</td><td>2809</td><td>395</td><td>Filing a submission after final rejection (37 CFR § 1.129(a))</td><td></td></tr> <tr><td>1810</td><td>790</td><td>2810</td><td>395</td><td>For each additional invention to be examined (37 CFR § 1.129(b))</td><td></td></tr> <tr><td>1801</td><td>790</td><td>2801</td><td>395</td><td>Request for Continued Examination (RCE)</td><td></td></tr> <tr><td>1802</td><td>900</td><td>1802</td><td>900</td><td>Request for expedited examination of a design application</td><td></td></tr> </tbody> </table> <p>Other fee (specify) _____</p> <p>*Reduced by Basic Filing Fee Paid</p>				Large Entity		Small Entity		Fee Description	Fee Paid	Fee Code	Fee (\$)	Fee Code	Fee (\$)	1051	130	2051	65	Surcharge - late filing fee or oath		1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet		1053	130	1053	130	Non-English specification		1812	2,520	1812	2,520	For filing a request for ex parte reexamination		1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action		1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action		1251	120	2251	60	Extension for reply within first month		1252	450	2252	225	Extension for reply within second month		1253	1,020	2253	510	Extension for reply within third month		1254	1,590	2254	795	Extension for reply within fourth month		1255	2,160	2255	1,080	Extension for reply within fifth month		1401	500	2401	250	Notice of Appeal		1402	500	2402	250	Filing a brief in support of an appeal	500.00	1403	1,000	2403	500	Request for oral hearing		1451	1,510	1451	1,510	Petition to institute a public use proceeding		1452	500	2452	250	Petition to revive - unavoidable		1453	1,500	2453	750	Petition to revive - unintentional		1501	1,400	2501	685	Utility issue fee (or reissue)		1502	490	2502	245	Design issue fee		1503	660	2503	330	Plant issue fee		1460	130	1460	130	Petitions to the Commissioner		1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)		1806	180	1806	180	Submission of Information Disclosure Stmt		8021	40	8021	40	Recording each patent assignment per property (times number of properties)		1809	790	2809	395	Filing a submission after final rejection (37 CFR § 1.129(a))		1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))		1801	790	2801	395	Request for Continued Examination (RCE)		1802	900	1802	900	Request for expedited examination of a design application	
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<p><b>SUBMITTED BY</b></p>				<p>Complete (if applicable)</p>	
Name (Print/Type)	Stephen T. Neal	Registration No. (Attorney/Agent)	47,815	Telephone	(408) 975-7500
Signature	<i>Stephen T. Neal</i>	Date	November 3, 2005		

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Patent

Attorney Docket No.: 12553/94

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANTS : Ming Gao YAO et al.  
SERIAL NO. : 10/603,444  
FILED : June 24, 2003  
FOR : SYSTEM AND METHOD FOR MANUFACTURE OF A  
HARD DISK DRIVE ARM AND BONDING OF  
MAGNETIC HEAD TO SUSPENSION ON A DRIVE  
ARM  
GROUP ART UNIT : 1725  
EXAMINER : Jonathan J. JOHNSON

**VIA FACSIMILE**

M/S: APPEAL BRIEF – PATENT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office via facsimile number (571) 273-8300 or deposited with the United States Postal Service as first class mail in an envelope addressed to: M/S: APPEAL BRIEF – PATENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on	
Dated: November 3, 2005	Signature: <u>Barbara Vance</u> Barbara Vance

**ATTENTION: Board of Patent Appeals and Interferences****APPEAL BRIEF**

Dear Sir:

This brief is in furtherance of the Notice of Appeal, filed in this case on September 6,  
2005.

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**1. REAL PARTY IN INTEREST**

The real party in interest in this matter is SAE Magnetics (H.K.) Ltd. (Recorded November 17, 2003, Reel/Frame 014698/0612).

**2. RELATED APPEALS AND INTERFERENCES**

There are no related appeals.

**3. STATUS OF THE CLAIMS**

Claims 16-28 are pending in the application. Claims 16-23 were rejected under 35 U.S.C. §103(a). Claims 24-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

**4. STATUS OF AMENDMENTS**

No amendments are currently outstanding.

**5. SUMMARY OF THE CLAIMED SUBJECT MATTER**

Independent claim 16 recites a method for manufacturing a data storage device. A placement device 305 physically stabilizes a hard drive head device 321 for electrical bonding of the head device 321 to a hard drive arm component 324. (See Figure 3 and p. 5, paragraph 14). The placement device 305 also physically stabilizes the hard drive arm component 324. (See Figure 3 and p. 5, paragraph 14). The placement device 305 uses sub-ambient pressure to

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maintain the position of said head device 321 with respect to said arm component 324 for said electrical bonding. (See **Figure 3** and p. 5, paragraph 14).

## **6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

**A. Claims 16-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of U.S. Patent No. 3,566,207 to Adams et al., (hereinafter "Adams").**

## **7. ARGUMENT**

**A. Claims 16-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over the AAPA in view of Adams.**

Independent claim 16 of the present invention describes a method for manufacturing a data storage device. A placement device physically stabilizes a hard drive head device for electrical bonding of the head device to a hard drive arm component. The placement device also physically stabilizes the hard drive arm component. The placement device uses sub-ambient pressure to maintain the position of said head device with respect to said arm component for said electrical bonding. Claims 17-23 depend from claim 16.

Appellants respectfully submit that neither the AAPA or Adams teach or suggest the placement device physically stabilizing the hard drive head device and the hard drive arm component, as recited in claims 1, 9, and 19. Adams, which discloses using vacuum chuck to mount a silicon chip on a gold-surfaced mounting pad, does not disclose this feature nor, does the Examiner claim that it does. (See Col. 3, lines 68-75). Instead, the Examiner relies on the AAPA as embodied in Figure 2. The AAPA states:

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A base support 211 and a first clamping cover 220 stabilize the magnetic head 202. A second clamping cover 221 stabilizes the suspension tongue 206. A second base support (not shown) secures the load beam 212.

(See AAPA, p. 3, paragraph 4).

In other words, the AAPA has one device, the clamping cover 220, stabilizing the magnetic head device and a second device, the second base support, securing the load beam 212, rather than a single placement device stabilizing both. Therefore, the cited references do not disclose all the elements of the claim, as set forth in claims 16. Appellants respectfully submit, therefore, that elements of claim 16 are neither shown nor suggested by the cited reference. Claims 17-23 depend from claim 16.

In addition and in the alternative, Appellants respectfully submit that there is no suggestion or motivation to combine the background of the application and Adams beyond the impermissible use of hindsight. The Examiner references Col. 3, lines 50-75 of Adams as providing a motive to combine. The relevant portion of Adams cited by the Examiner states:

Alternatively, the chip 14 may be held in a vacuum chuck 64, also shown in FIG. 5, for placing the chip 14 on the mounting pad 16 of the lead frame 18, and may be employed for applying slight pressure downwardly, if desired, of a magnitude of about a few grams. (Adams, Col. 3, lines 68-75).

Adams clearly provides no such motive to combine, as the portion cited by the Examiner does not state what advantage may come from replacing the clamps of the AAPA with the vacuum chuck of Adams. Such motive would have to come from the AAPA, meaning that the motive combine came from the Appellants own insight.

Therefore, Appellants submit that a *prima facie* case of obviousness has not been made. The MPEP requires that the references must suggest making the combinations. MPEP §2141.01 (citing *Hodosh v. Block Drug Co., Inc.*); §706.02(j) (the initial burden is on

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the examiner to provide a convincing line of reasoning with explicit or implicit suggestions to combine references).

Merely stating that it would have been obvious for a person of ordinary skill in the art to combine references, without pointing to a specific hint or suggestion to combine, has been rejected by the Federal Circuit, as an invalid basis of rejection under 35 U.S.C. §103. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (the court rejected a conclusory statement that it would have been obvious to combine the references without evidence of a teaching, motivation, or suggestion to select and combine the references, citing numerous cases); *In re Dembiczak*, 175 F.3d 994,999 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”) It would be impossible for these references to be combined minus hindsight. Any motive to combine present in the background section of the application would be from the applicant or hindsight and not the result of any prior art.

Accordingly reconsideration and withdrawal of the rejection of claims 16-23 under 35 U.S.C. §103(a) is respectfully requested.

Appellants therefore respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner’s decision rejecting claims 1-26 and direct the Examiner to pass the case to issue.



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The Examiner is hereby authorized to charge any additional fees, which may be necessary for consideration of this paper to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

Date: November 3, 2005

By: 

Stephen T. Neal  
(Reg. No. 47,815)

KENYON & KENYON  
333 West San Carlos St., Suite 600  
San Jose, CA 95110

Telephone: (408) 975-7500  
Facsimile: (408) 975-7501

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## APPENDIX

(Brief of Appellant Ming Gao YAO et al.  
U.S. Patent Application Serial No. 10/603,444)

### 8. CLAIMS ON APPEAL

16. A method for manufacturing a data storage device comprising:  
physically stabilizing, by a placement device, a hard drive head device for electrical bonding of said head device to a hard drive arm component;  
physically stabilizing, by the placement device, the hard drive arm component; and  
utilizing, by said placement device, sub-ambient pressure to maintain the position of said head device with respect to said arm component for said electrical bonding.
17. The method of claim 16, wherein said hard drive head device is a hard disk drive magnetic head.
18. The method of claim 17, wherein said hard drive arm component is a suspension tongue.
19. The method of claim 16, wherein said electrical bonding is ball bonding.
20. The method of claim 19, wherein said electrical bonding is a type selected from the group consisting of gold ball bonding (GBB), solder bump bonding (SBB), ultrasonic welding, and stitch bonding.
21. The method of claim 20, wherein said placement device includes a first vacuum tube structure for providing said sub-ambient pressure to affix said first vacuum tube structure to said

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head device.

22. The method of claim 21, further comprising:  
providing an alignment pin protruding from said placement device.
23. The method of claim 22, wherein said alignment pin is capable of being inserted into a suspension tooling hole for ensuring said proper alignment.
24. The method of claim 22, further comprising:  
providing sub-ambient pressure, by a second vacuum tube;  
vacuum-coupling said first vacuum tube structure to said head device; and  
vacuum-coupling said second vacuum tube structure to a suspension load beam attached to said arm component.
25. The method of claim 24, wherein the first vacuum tube structure includes a step structure mate-able to an edge of the head device.
26. The method of claim 25, wherein said step structure is mate-able to at least the leading edge of said head device.
27. The method of claim 24, wherein said first vacuum tube structure is a material selected from the group consisting of Stainless Steel, Copper, Aluminum Oxide, Polyimide, and Ceramic.

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28. The method of claim 24, wherein said second vacuum tube structure is a material selected from the group consisting of Stainless Steel, Copper, Aluminum Oxide, Polyimide, and Ceramic.

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## **9. EVIDENCE APPENDIX**

No further evidence has been submitted with this Appeal Brief.

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#### **10. RELATED PROCEEDINGS APPENDIX**

Per Section 2 above, there are no related proceedings to the present Appeal.